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10/30/02

PATENT

Customer No. 22,852

Attorney Docket No. 06999.0010-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

OCT 25 2002

In re Application of:

Austin SMITH et al.

Serial No.: 09/786,817

Filed: March 9, 2001

For: PROPAGATION AND/OR  
DERIVATION OF EMBRYONIC  
STEM CELLS

)  
)  
) Group Art Unit: 1632

)  
) Examiner: Michael Wilson

TECH CENTER 1600/290

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

RESPONSE

This is a response to the restriction requirement imposed by the Examiner in an Office Action dated September 20, 2002 (the period for reply having been extended for one month by a request for extension and fee payment filed concurrently with this response). Applicants provisionally elect, with traverse, to prosecute the claims of Group II (claims 12, 14-21, 25-28, 30-39, 43, 44, and 46-50). These claims are directed to a composition comprising (a) a compound that promotes propagation of ES cells and (b) a compound that inhibits the ras/MAPK cascade, a culture medium comprising the composition, a method of culturing ES cells with the composition, and a method of culturing ES cells with a compound that inhibits the ras/MAPK cascade. Applicants further provisionally elect the species designated PD09059 recited in claims 46-49. Claims 12, 14-21, 25-28, 30-39, 43, and 46-49 read on the elected species.

The Examiner argues that the individual claim groups are not so linked as to form



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a single general inventive concept under PCT Rule 13. Applicants disagree that there is no single general inventive concept. Moreover, Applicants are confused as to why the Examiner believes that there should be a multi-way restriction requirement under PCT Rule 13 when both the PCT Searching and Examining Authorities did not consider the claims to lack unity of invention. In fact, the PCT Searching Authority issued an International Search Report on all of the original 45 claims and the International Examining Authority examined all of the original claims together and issued an International Examination Report on all of the claims.

Contrary to the Examiner's assertion, the restricted claims do share a single inventive concept and corresponding technical feature: each recites a first compound that promotes propagation or survival of ES cells and a second compound that inhibits propagation or survival of ES cells. Although the second compounds vary in the mechanism by which they inhibit the propagation or survival of ES cells, they all share this technical feature and should be examined together. Both the PCT International Searching and Examining Authorities agree that the claims share this a single inventive concept and corresponding technical feature. Accordingly, Applicants respectfully submit that the restriction requirement is not well founded and should be withdrawn in its entirety.

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Applicants believe that any extension of time required for entry of this Response is accounted for in the accompanying Petition for Extension of Time. However, in the event of an error, please grant any additional extensions of time required to enter the Response and charge any additional required fees to deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 23, 2002

By: 

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